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46797 7590 12/22/2010 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829				
EXAMINER BEKIRMAN, MICHAEL				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/887,621  
Filing Date: June 22, 2001  
Appellant(s): BATES ET AL.

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Gero G. McClellan  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/05/2010 appealing from the Office action mailed 5/5/2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

2004/0143502	MCCLUNG	7/2004
2001/0042785	WALKER	11/2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11, 13-18, 20-22, and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClung (U.S. Pub No. 2004/0143502).

Referring to claims 1-7, 11, 13-18, 22, and 24-26, McClung teaches a host computer system as tracking a transaction by the item and purchase price, receiving and storing price matching data including an item match price, comparing the purchase price to a comparison price (item match price) periodically (over different time periods), and administering a credit for the price differential to the customer if the comparison price is lower than the purchase price (Paragraph 0007). The system would inherently have to obtain an account number (customer identification number) in order to credit the customer's account. McClung also teaches the credit card account as being an account with the vendor (Paragraph 0008, Sentence 3 and Paragraph 0131, Sentence 1). A step of determining whether a user is using a vendor credit card (and therefore, signed up through a vendor) is inherent when a purchase takes place via credit card (regular Visa versus a store card, and vice versa). McClung, however, does not specify what action takes place should a user not have an account with the system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an *explanation* of the types of savings (such as *price matching* or *price guarantees*) that could be incurred through signing up. This would provide a greater chance of that non-member signing up.

Referring to claims 8, 10, 21, and 28, McClung teaches a price-guarantee period (Paragraph 0007). Recording and comparing purchase and current dates is inherent in offering the price-guarantee period.

Referring to claims 9, 20, and 27, McClung teaches a price-guarantee period that could be (but not limited to) a week, a month, 3 months, 6 months, or a year (Paragraph

0007). McClung also teaches the monitoring competitors on a real time basis (Paragraph 0009, Sentence 2). McClung doesn't specify the price-guarantee period as being same-day and doesn't describe what would happen should a customer purchase a product in the morning with a lower comparison price appearing in the system later in the day. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the price-guarantee period be whatever time period the retailer would prefer, including same-day. This would make the system more attractive to retailers by allowing them more choices.

Claims 11, 12, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClung (U.S. Pub No. 2004/0143502) in view of Walker (U.S. Pub No. 2001/0042785).

Referring to claims 11, 12, 29, and 30, McClung teaches crediting an account with a vendor to implement a guaranteed pricing promotion. McClung doesn't teach the transferring of balances between different credit accounts. Walker teaches that it is well-known to transfer debt balances between accounts to take advantage of different account features (Paragraph 0011, Sentence 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer a credit balance from one account to another in order to take advantage of retailer guaranteed pricing. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to

potential credits that could be incurred through transferring a balance. This would provide a greater chance of that non-member transferring the balance.

#### **(10) Response to Argument**

Appellant argues that partial payment for multiple items using both cash and credit card would not indicate which items were paid for with the credit card and which were paid for with the cash. Based on this argument, Appellant indicates that the inherency relied upon is flawed. However, Appellant's claims do not currently require multiple items to be purchased, and therefore this argument is moot. In other words, if only 1 item is purchased using the system of McClung, then the Appellant's argument is moot with respect to multiple items being purchased. Regardless, the point of the inherency is that whenever a credit card is used, a system automatically determines the type of card as being a vendor card. If a card is swiped after 1 or multiple items are scanned, then the system determines and understands the type of card. Whether a partial payment was made does not matter, so long as a credit card was used. Further, when a partial payment is made using cash and credit card, there is no identification of specific items purchased using each payment method. Every item purchased is purchased partially with the credit card and the cash. Appellant uses the example of multiple items purchased, however what if 1 item is purchased using several payment methods. The item is considered to be paid for with all payment methods. We don't break apart the item and specifically label which components were purchased with the

credit card and which were purchased with the cash. That doesn't make sense.

Therefore, the inherency relied upon by the Examiner appears to be sound.

Appellant argues "McClung does not teach or suggest that different actions are performed based upon the determination of whether the item is purchased using a store credit card account". McClung teaches signing up with a *vendor* to have amounts *credited* in Paragraph 0008. Another reference to this can be found at Paragraph 0131, Sentence 1. At this citation, McClung is quoted as teaching "an entity (e.g. but not limited to, a financial institution, a network, an ISP, a retail business, or an on-line entity) may have a consumer register or sign-up to receive the benefit of a best price guarantee". This appears to be a store credit account, and the Examiner stands by this interpretation. This also leads to the interpretation that if a consumer is not signed up, the price guarantee may not be implemented.

Appellant further argues that McClung does not teach a distinction between actions performed based on whether a store account was or was not used. However, in the rejection, Examiner points out that McClung teaches one situation, and in the case of the other, it would be obvious to notify consumers about the availability of the other option. McClung was never cited as containing all elements of the claim, which is why a 103 rejection was given as opposed to a 102.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was



within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971)

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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